

## **REMARKS/ARGUMENTS**

### **Claim Rejections**

#### **35 U.S.C. §102 Rejections**

In the Office Action, Claims 1-4, 6, 8, 9, 11-24, 26-31, 34-39, 41, 42, 44-52, 54, 56, 57, 59-61 were rejected as being anticipated by Published U.S. Patent application No. 2003/0046238 to Nonaka et al. (hereinafter "*Nonaka*"). Applicant respectfully submits that these claims, as previously amended, are patentable over *Nonaka*.

Independent Claims 1, 31, 34, and 49 were previously amended to clarify that "the present invention can store rights and/or usage information *in clear form* on a client device while still providing security for the content and integrity for the rights/usage information." See the published version of the current application (No. 2005/0022025) (hereinafter "Current Application") at paragraph [0017] (emphasis added). As previously discussed, storing the information in clear form is beneficial because it can greatly simplify rights enforcement and/or usage reporting because the information does not need to be decrypted before it can be read or used either on the client device or by an external device. This simplification is especially advantageous when a simple, inexpensive client device lacks resources to do unnecessary decryption.

Applicants previously argued that *Nonaka* does not teach that rights and/or usage information may be stored in clear form. But in the Office Action, the Examiner rejected these arguments. However, Applicants respectfully submit that this rejection was based on an imperfect interpretation of *Nonaka* and that when properly considered, *Nonaka* cannot be said to teach that rights and/or usage information may be stored in clear form as presently claimed. Accordingly, Applicant respectfully submits that the Examiner has not established a *prima facie* case for anticipation.

To establish a *prima facie* case of anticipation, the Examiner is obligated to identify where "each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.2d 1461, 1462 (Bd. Pat. App. & Intef. 1990). Furthermore, anticipation requires that each and every claim element must be identical to a corresponding element in the applied reference. *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995). The Office Action fails to present such a *prima facie* case of anticipation.

### Claims 1, 31, 34, 49

*Nonaka* teaches that Usage Control Policy (UCP, i.e. rights) information is used to create an *encrypted* content key, which is then used to encrypt content data. *Nonaka* paragraph [0019], lines 1-6; *see also, e.g., Nonaka* paragraph [0250] (UCP data transmitted in a secure container).

By contrast, previously amended Claim 1 reads as follows:

1. A method comprising:
  - obtaining an integrity hash of rights information stored **in a clear form** at a client device, said rights information being associated with content stored at the client device;
  - encrypting the integrity hash using a client device key to generate an encrypted hash, said client device key being externally inaccessible from the client device; and
  - storing the encrypted hash on the client device

(emphasis added). Storing the information in clear form provides a level of functionality and convenience that is not taught or suggested by *Nonaka*, a level of functionality that is in fact antithetical to the teaching of *Nonaka*. This simplification is especially advantageous when a simple, inexpensive client device lacks resources to do unnecessary decryption. *See* Current Application, paragraph [6].

In the office action, the Examiner argues that *Nonaka* discloses the ability to store rights in an unencrypted (clear text) form, citing *Nonaka* paragraphs [192] and [239]. However, Applicants respectfully submit that these references teach merely that the rights information may be encrypted **by the content provider**, rather than by the electronic music distribution (“EMD”) service center, as is the usual practice. For example, paragraph [192] of *Nonaka* reads as follows: “the UCP data may not be encrypted **with the license key data** [from the EMD service center] ... in which case, the signature data **encrypted with the private key data of the content provider** is added to the UCP data” (internal citations omitted). Similarly, paragraph [239] states merely that in some cases, the rights information may be “provided with signature data [i.e. hashed] without being encrypted **by the license key data**.” So in all cases, *Nonaka* teaches that rights information is encrypted or hashed, either by the license key of the EMD service center or by the private key of the content provider.

Accordingly, Applicants respectfully submit that *Nonaka* does not anticipate Claims 1, 31, 34, and 49 and request that these claims be allowed.

**Claims 2-4, 6, 8-9, 11-19, 35-39, 41-42, 44-48, 50-52, 54, 56, 57, 59-61**

As an initial matter, Claims 2-4, 6, 8-9, 11-19, 35-39, 41-42, 44-48, 50-52, 54, 56, 57, 59-61 depend from allowable independent claims and are therefore allowable for the reasons noted above. However, there are additional bases on which to allow these claims.

For example, as previously argued, *Nonaka* does not anticipate Claims 4, 15, 37, 46, and 52 because *Nonaka* does not teach the use of a “client device key.” In asserting that *Nonaka* anticipates Claims 4, 15, 37, 46, and 52, the Office Action incorrectly asserts that *Nonaka*’s “license key” is the same as the claimed “client device key.” Applicants wish to correct this notion, as *Nonaka*’s “license key” differs radically from the claimed “client device key” both because the latter is unique to each device and because the former is accessible through an external data path. The Office Action rejected the former argument, asserting that there is no disclosure in the specification or the original claims that the device key is unique. However, the Office Action did not address the latter argument, indicating, at least implicitly, that the latter argument has merit.

Applicants concede that the term “unique” does not appear in the specification, but argue that it is implicit throughout. For example, “a client device...often includes a hardware key embedded within the device.” Para. [17]. This client key is used, at least in part to track usage and update content usage information and record tampering. *See* Paras. [39-41]. If the client device key were not unique, but were common to a set of client devices, then it stands to reason that content could be played on many different client devices, at least partially defeating the purpose of controlling content access. However, even assuming for the sake of argument that the specification does not disclose a **unique** device key, *Nonaka* still cannot be said to anticipate Claims 4, 15, 37, 46, and 52 because *Nonaka* undeniably teaches that a license key is accessible through an external data path whereas the specification teaches equally undeniably that a “client device key” is externally **inaccessible** from the client device.

The claimed client device key is described as follows, “Security and integrity can be provided on the client device by using a device key that is externally inaccessible from the client device...” Current application paragraph [17].

*Nonaka*’s “license key” differs radically from the “client device key” at least because a “license key” may be sent across a network to a client device. *See Nonaka*, paragraph [99]. [304]. Thus, a license key **must be accessible through an external data path**.

Furthermore, *Nonaka* teaches that a “license key” is not tied to a client device, but is tied to a particular piece of content. See *Nonaka*, paragraph [20] (“license key data for decrypting the content key data is distributed”); [36] (“the content key data may be encrypted with license key data having an effective period”).

The Office Action does not controvert these key distinctions. Accordingly, because a “license key” cannot be analogized to a “client device key,” the Applicant respectfully submits that *Nonaka* does not anticipate Claims 4, 15, 37, 46, and 52.

For another example, *Nonaka* does not anticipate Claims 11, 12, 44, and 60 because, as discussed at length above, *Nonaka* does not teach storing or transferring rights information in clear form.

There are other examples of additional reasons why *Nonaka* does not anticipate Claims 2-4, 6, 8-9, 11-19, 35-39, 41, 42, 44-48, 50-52, 54, 56, 57, 59-61. But while Applicants respectfully submit that there is merit in the additional arguments made previously, Applicants will not reiterate those arguments here. Rather, Applicants respectfully submit that Claims 2-4, 6, 8-9, 11-19, 35-39, 41, 42, 44-48, 50-52, 54, 56, 57, 59-61 depend from allowable independent claims and are therefore allowable. Furthermore, Claims 2-4, 6, 8-9, 11-19, 35-39, 41, 42, 44-48, 50-52, 54, 56, 57, 59-61 are allowable at least for the additional reasons discussed above.

#### **Claim 20**

Claim 20, as originally written, includes “storing the rights information and the first integrity hash at the client device in a clear form.” As discussed generally above, *Nonaka* does not teach or suggest storing rights information in clear form. Accordingly, *Nonaka* does not anticipate Claim 20.

#### **Claims 21-24, 26-30**

Claims 21-24, 26-30 depend from allowable independent Claim 20 and are therefore allowable for the reasons noted above. Similar to Claims 2-4, 6, 8-9, 11-19, 35-39, 41, 42, 44-48, 50-52, 54, 56, 57, 59-61, there are numerous additional reasons that Claims 21-24, 26-30 are allowable. As just one example, Claim 26 is allowable because, as discussed at length above, *Nonaka* does not teach storing or transferring rights information in clear form. As with Claims 2-4, 6, 8-9, 11-19, 35-39, 41-42, 44-48, 50-52, 54, 56, 57, 59-61, there are other examples of why *Nonaka* does not anticipate Claims 21-24, 26-30; however, Applicant need not go further into

those reasons because Claims 21-24, 26-30 are allowable because they depend from allowable independent Claim 20.

### **35 U.S.C. §103 Rejections**

#### **Claims 5, 7, 25, 40, 53, 55**

In the Office Action, Claims 5, 7, 25, 40, 53, 55 were rejected as being obvious considering *Nonaka* in view of Serret-Avila's US Patent No. 6,959,384 (hereinafter "Serret-Avila"). Applicant respectfully submits that these claims are patentable over *Nonaka* in view of *Serret-Avila*.

As an initial matter, Claims 5, 7, 25, 40, 53, 55 all depend from independent Claims that are allowable because, as discussed above, *Nonaka* does not teach or suggest storing rights information in clear form. Therefore, Claims 5, 7, 25, 40, 53, 55 are allowable because they depend from allowable independent claims. However, Claims 5, 7, 25, 40, 53, 55 are also allowable for additional reasons. The following is a nonexclusive listing of additional reasons why Claims 5, 7, 25, 40, 53, 55 are allowable.

The Office Action correctly notes that the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). However, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, according to the most recent U.S. Supreme Court decision regarding obviousness, it remains "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements." *KSR Int'l. Co v. Teleflex Inc.*, 127 S. Ct. 1727, 167 L. Ed. 2d 705, 722 (April 30, 2007). The Court elaborates, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 720. Applicants respectfully submit not only that there is no reason that would have prompted a person of ordinary skill in the art to combine *Nonaka* with *Serret-Avila*, but also that the combination of *Nonaka* and *Serret-Avila* would not yield the results obtained in the claims.

Claims 5, 7, 25, 40, 53, 55 are allowable because one of ordinary skill in the art to which the subject matter sought to be patented pertains would not have been motivated to modify

*Nonaka* as taught by *Serret-Avila*. The subject matter sought to be patented pertains to rights enforcement and usage reporting. Current Application paragraph [1]. More specifically, it pertains to storing rights information and providing security for content data stored on a client device, a client device that may or may not have the resources to manage content and external communications. *See* Current Application paragraph [6], [17].

As previously argued, a person of ordinary skill in that art would not have been motivated to consider the teachings of *Serret-Avila* because *Serret-Avila* pertains to subject matter that is at most only distantly related to the problems of storing rights and usage information on a client device. Furthermore, *Serret-Avila* teaches away from the solutions described in the present invention. The present invention most typically pertains to a client device that stores a set of rights and/or usage information, *see* Current Application, paragraph [17], a set of information that must be kept safe from tampering, but a set of information that is most desirably kept in clear form. The problem solved by the present invention, then, is how a client device may simply maintain the integrity of a relatively small set of data, data that is most conveniently stored in clear form. *Serret-Avila* explicitly rejects as problematic approaches that rely for authentication on a client's possessing an entire set of data. In short, contrary to the Office Action's suggestion, a person of ordinary skill working with the subject matter of the present invention would have had no need to enable fast, secure, and efficient authentication of data streams, as taught by *Serret-Avila*. Furthermore, *Serret-Avila* teaches away from the solutions described in the claims. Accordingly, Claims 5, 7, 25, 40, 53, 55 are allowable.

#### **Claims 10, 32, 33, 43, 58**

In the Office Action, Claims 10, 32, 33, 43, 58 were rejected as being obvious considering *Nonaka* in view of Chase's US Patent No. 7,080,043 (hereinafter "*Chase*"). Applicant respectfully submits that these claims are patentable over *Nonaka* in view of *Chase*.

As an initial matter, Claims 10, 32, 33, 43, 58 all depend from independent Claims that are allowable because, as discussed above, *Nonaka* does not teach or suggest storing rights information in clear form. Therefore, Claims 10, 32, 33, 43, 58 are allowable because they depend from allowable independent claims. However, Claims 10, 32, 33, 43, 58 are also allowable for at least the following additional reasons.

Even considering *Nonaka* in view of *Chase*, disabling content on the client device would not have been obvious to a person of ordinary skill in the art because *Chase* relies on interaction

with an external license server to manage content revocation. *See Chase*, column 34, lines 23-24. Because *Chase* teaches that client devices must communicate with a license server that will make determinations about issuing and/or revoking rights information, one of ordinary skill in the art seeking to disable content on a device that cannot communicate externally would have had no motivation to combine *Nonaka* with *Chase*. *See Chase*, column 34, lines 23-24. Furthermore, *Chase* teaches that a content owner “wants the ability to disable access to its content across all applications without having to identify each application or component.” *Chase*, column 33, lines 54-56. Therefore, if one of ordinary skill in the art had for some reason combined the two references, he or she would not have accomplished the results yielded by the claimed invention, in which each client device makes the individual determination as to whether to disable content one at a time. *See Current Application*, paragraph [0006]. Accordingly, one of ordinary skill in the art would not have been motivated to consider *Nonaka* in view of *Chase*. Therefore, Claims 10, 32, 33, 43, 58 are allowable.

## **CONCLUSION**

Applicant submits that all pending claims are in condition for allowance. Accordingly, early and favorable action allowing all of the pending claims and passing this application to issue is respectfully requested. The Examiner is invited to contact the undersigned at the telephone number below if there are any remaining questions regarding this application.

Applicants believe that no fees are required. If, however, insufficient fee payment or fee overpayment occurs, the amount may be withdrawn or deposited from/to our firm's deposit account. The deposit account number is 50-4051.

Respectfully submitted,  
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